

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number

Q79404

Mail Stop AF
 Commissioner for Patents
 P.O. Box 1450 Alexandria, VA 22313-1450

Application Number

10/765,359

Filed

January 28, 2004

First Named Inventor

Hiroaki KISHIOKA

Art Unit

1794

Examiner

Anish P. Desai

WASHINGTON DC SUGHRUE/265550

65565

CUSTOMER NUMBER

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal

The review is requested for the reasons(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

☒ I am an attorney or agent of record.

Registration number 40,641

/Jennifer M. Hayes/

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December 31, 2008

Date

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q79404

Hiroaki KISHIOKA, et al.

Appln. No.: 10/765,359

Group Art Unit: 1794

Confirmation No.: 1537

Examiner: Anish P. Desai

Filed: January 28, 2004

For: DOUBLE-SIDED PRESSURE-SENSITIVE ADHESIVE SHEET AND TOUCH PANEL-
PROVIDED DISPLAY DEVICE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated July 31, 2008, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejections at issue:

Claims 1, 2 and 5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kishioka (US 2002/0098352 A1) in view of [Hitoshi] Takahira et al (EP 0930322A2) (hereinafter EP '322). Claims 1, 2, 5 and 6 are further rejected under 35 U.S.C. § 103(a) as being unpatentable over Okabe et al (Abstract of JP 07-105781) in view of Kishioka (US 2002/0098352A1) and EP '322.

Applicants traverse the rejections and submit that the Examiner has not made a *prima facie* showing of obviousness.

The present invention is directed to a double-sided PSA sheet having the following features: (1) at least two PSA layers; (2) no substrate; (3) optical isotropy; (4) thickness of not more than 50 μm ; (5) PSA layer in the touch panel side having a 180°-peeling adhesive strength (to a norbornene based resin film at a peeling rate of 300 mm/min at 23°C) of 5.5 N/20 mm or more; (6) PSA layer in the display device side having a 180°-peeling adhesive strength (to a glass plate or a triacetyl cellulose film at a peeling rate of 300 mm/min at 23°C) of not more than 5.0 N/20 mm; (7) the double-sided pressure-sensitive adhesive sheet is repeatedly peelable from the display surface of the display device together with the touch panel; (8) each PSA layer comprises an acrylic polymer containing (meth)acrylic acid alkyl ester in which the alkyl moiety has from 1 to 18 carbon atoms selected from the monomers recited in claim 1; (9) the major monomer for the respective PSA layers is constituted from the same kind of monomer; and (10) the major monomer component constituting each PSA layer is 80% by weight or more based on the whole amount of the monomer components.

Appellants have pointed out that at least the combination of features (5) and (6) is not taught or suggested by any of the cited references. The Examiner takes the position that these features are believed to be present in the double-sided PSA tapes of Kishioka as modified by EP '322. However neither of these references, teaches or even mentions the adhesive strength of a PSA layer in the touch panel side and the adhesive strength of a PSA layer in the display device side. Further, neither of these references teaches or suggests the relationship of the different

adhesive strengths of the PSA layer on the touch panel side and the PSA layer on the display panel side, wherein the adhesive strength of the PSA layer on the touch panel side is higher than the peeling strength of the PSA layer of the display side, i.e., 5.5 N/20 mm or more vs. not more than 5.0 mm, respectively. For at least this reason, the cited references do not teach or suggest the claimed invention, whether taken alone or in combination.

The Examiner's position that these features are believed to be present in the double-sided PSA tapes of Kishioka as modified by EP '322 is based on the assertion that the PSA tapes of Kishioka as modified by EP '322 are structurally and compositionally equivalent. However, Appellants submit that the Examiner is not correct in this regard.

First, the thickness of the total double-sided PSA sheet of the claimed invention is not more than 50 μ m. Kishioka teaches the thickness of the PSA layer in the range of from 5 to 500 μ m and more preferably in the range of from about 10 to 100 μ m. Kishioka does not specifically teach the total thickness of a double-sided PSA sheet having at least two PSA layers. There are thousands of possible combinations of the thicknesses of the two PSA layers and there is no apparent reason to choose two or more PSA layers, each having a thickness within the very broad range taught by Kishioka, such that the total thickness would be within the claimed range of not more than 50 μ m.

EP '322 also teaches the thickness of the PSA layer and fails to teach or suggest the total thickness of a double-sided PSA sheet having at least two PSA layers. EP '322 teaches that the PSA layer has a thickness of from 10 to 100 μ m. There are thousands of possible combinations of the thicknesses of two PSA layers having a thickness within the range taught by EP '322 and

there is no apparent reason to choose two or more PSA layers, each having a thickness within the range taught by EP '322, such that the total thickness would be within the claimed range of not more than 50 μm .

The total thickness of not more than 50 μm leads to excellent optical characteristics as can be seen from Examples 1 and 2 in Table 1 of the specification. Thus, even if Kishioka and EP '322 were combined, one of ordinary skill in the art would not necessarily arrive at the claimed total thickness range and therefore, for at least this reason, it cannot be said that the PSA tape of Kishioka modified by EP '322 would be structurally equivalent to the present invention.

Further, even if Kishioka and EP '322 were combined, the PSA tape of Kishioka modified by EP '322 would not be compositionally equivalent to the claimed invention. Present claim 1 requires that the major monomer in the PSA layers is the same monomer. The Examiner states that Kishioka is relied on as teaching that both PSA layers are formed of the same monomer at paragraph [0065]. However, there is no disclosure in this portion of Kishioka (or any other portion) indicating that the PSA layers are formed of the same monomer. Therefore, Applicants submit that the Examiner is mistaken.

EP '322 also fails to teach or suggest that the major monomer in the PSA layers is the same monomer. Also, the disclosure of EP '322 at paragraph [0036] cannot be fairly interpreted as reading on a double-sided adhesive sheet having at least two PSA layers and no substrate, since this portion of EP '322, specifically teaches "the layer of the pressure-sensitive adhesive is stuck to one surface or both surfaces of the base material and . . . can be used as a pressure sensitive adhesive sheet having the base material."

Thus, it cannot be said that the PSA tape of Kishioka modified by EP '322 would be compositionally equivalent to the claimed invention.

Since the PSA tape of Kishioka modified by EP '322 would not be structurally and compositionally equivalent to the claimed invention for the reasons set forth above, the properties recited in the claims are not necessarily present as it has been established that inherency cannot be based on probabilities or possibilities.

Okabe also fails to teach or suggest at least the combinations of features (5) and (6) above and therefore, even if combined with Kishioka and EP '322, the present invention would not have been achieved.

In view of the above, the Examiner has not set forth a reasonable basis for asserting that all elements of the claimed invention are taught or suggested and therefore has not made a *prima facie* showing of obviousness.

Accordingly, Appellants respectfully request the Pre-Appeal Brief Conference Panel to withdraw the foregoing rejections in view of clear error in that the prior art references do not disclose, teach or suggest the presently claimed invention.

Respectfully submitted,

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